



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/407,806 09/28/99 MURPHY

D DIVER1120-1

EXAMINER

HM12/0621

LISA A. HAILE, PH.D.
GRAY CARY WARE AND FREIDENRICH, LLP
4365 EXECUTIVE DRIVE, SUITE 1600
SAN DIEGO CA 92121-2189

MAYHEW, B

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/407,806

Applicant(s)

Murphy et al.

Examiner

Bradley S. Mayhew

Group Art Unit

1652



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-12 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to polynucleotides encoding α -galactosidases, vectors comprising said polynucleotides, host cells comprising said vectors, and recombinant methods for expressing the encoded α -galactosidases, classified in class 435, subclass 69.1.
- II. Claims 10-11, drawn to an α -galactosidase, classified in class 435, subclass 208.
- III. Claim 12, drawn to methods for hydrolyzing α -galactose bonds, classified in class 435, subclass 72.

The inventions are distinct, each from the other because of the following reasons:

The products of Groups I and II are unrelated. The polypeptides of Group II and the polynucleotides of Group I each comprise chemically unrelated structures capable of separate manufacture, use and effect. The polynucleotides comprise nucleic acid sequences while the polypeptides comprise amino acid sequences. Additionally, the polynucleotides have other utility besides encoding the proteins, such as a hybridization probes, and the polypeptides have utility such as the purported utility of the methods of Group III.

The product of Group II is related to the process of Group III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

Application/Control Number: 09/407,806

Art Unit: 1652

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the processes for using the product of Group II, namely a process for hydrolyzing α -galactose, can be carried out, albeit not as efficiently, using standard methods of chemical hydrolysis using non-enzymatic catalysts.

The product of Group II is related to the expression process of Group I as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the polypeptide of Group II can be obtained by a process materially different from the recombinant expression methods of Group I, such as purification from naturally occurring sources.

The polynucleotides of Group I are unrelated to the methods of Group III as they are neither used by nor made by the methods of Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended

Art Unit: 1652

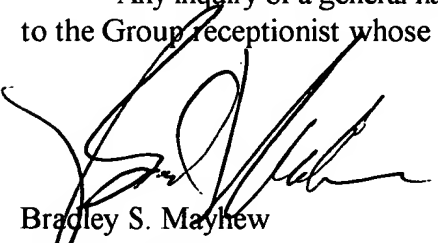
in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Advisory Information


1. **Any inquiry concerning this communication or earlier communications should be directed to Bradley S. Mayhew whose telephone number is (703) 308-9437. The examiner can normally be reached Monday-Thursday from 8:30 am to 6:00 pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu N. Achutamurthy, can be reached at (703) 308-3804. The fax phone number for Official and Unofficial Papers to the Examiner is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Bradley S. Mayhew
June 19, 2000



PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600